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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/796,671	03/09/2004	Keith Edward Foley	600.1263	3017
23280	7590	09/08/2008		
Davidson, Davidson & Kappel, LLC 485 7th Avenue 14th Floor New York, NY 10018			EXAMINER COLILLA, DANIEL JAMES	
			ART UNIT 2854	PAPER NUMBER
			MAIL DATE 09/08/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/796,671

**Applicant(s)**

FOLEY ET AL.

**Examiner**

Daniel J. Colilla

**Art Unit**

2854

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 4-6, 8, 11, 12, 14, 15, 17 and 19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 4-6, 8, 11, 12, 14, 15, 17 and 19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/808)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Double Patenting*

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claim 8 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 11/978,801.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the main difference between claim 1 of copending Application No. 11/978,801 and claim 8 of the current application is that claim 1 recites automatically adjusting “the first device” as a function of the information. The current application recites automatically adjusting “each device” as a function of the information. It would have been obvious to provide the same step to additional similar structures in order to achieve the same predictable result. Thus it would have been obvious to apply the same automatic adjustment step to all devices since it is known to apply the step to a first device.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

3. Claims 4-6, 14, 15 and 19 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 11/978,801 in view of Platteter *et al.* (US 5,629,775).

With respect to claim 4, Platteter *et al.* discloses that several different modules can be attached to the printing machine 10. These modules can include devices for stacking, mail box sorting, booklet making, binding, inserting, folding, etc. (Platteter *et al.*, col. 5, lines 17-27). In col. 2, lines 5-10, Platteter *et al.* discloses that the finishing and feeder devices maybe attached in any configuration that the operator decides is appropriate for his need. It would have been obvious to combine the teaching of Platteter *et al.* with the claim recited by copending Application No. 11/978,801 for the advantage of having several different types of finishing modules connected to a printing machine.

With respect to claim 5, as mentioned above with respect to claim 1, the module devices can include a binder thus the system can be considered a binding line. As disclosed in col. 2, lines 64-66, the attached devices can be feeding devices.

With respect to claim 6, the machine disclosed by Platteter *et al.* is a printing machine that can be used for printing books or booklets (col. 3, lines 2-17), thus, it can be considered a printing press and the devices attached can be considered printing press components.

With respect to claim 14, as mentioned in col. 5, lines 17-27 of Platteter *et al.*, the devices (including the first device 52) are modular.

With respect to claim 15, Platteter *et al.* disclose that the controller receives inputs from the devices regarding location during autoconfiguration (col. 5, lines 52-60).

With respect to claim 19, the type identifier taught by Platteter *et al.* includes components such as memory 24A and 28A for storing data and circuitry 24B and 28B which operate using digital signals.

This is a provisional obviousness-type double patenting rejection.

4. Claim 11 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 11/978,801 in view of Okano (US 2001/0011219).

Claim 1 of copending Application No. 11/978,801 recites the claimed graphics machine except that it does not specify if the memory 22A is a table or not. However, Okano teaches a controller 25 including a memory 25A that is a data table for storing information about different types of devices as mentioned in paragraph [0065] of Okano. It would have been obvious to combine the teaching of Okano with the graphics machine recited in claim 1 of the copending Application for the advantage of logically arranged and therefore easily accessible information stored in a memory.

This is a provisional obviousness-type double patenting rejection.

5. Claims 12 and 17 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 11/978,801 in view of Goers *et al.* (US 2002/0096942).

With respect to claim 12, claim 1 of the copending Application recites the claimed machine except that it is not known to the examiner how the devices connect to the machine. However, Goers *et al.* teaches a device 2 that connects to a machine 1 using an electrical plug as taught in paragraph [0026] of Goers *et al.* It would have been obvious to combine the teaching of Goers *et al.* with the machine recited in claim 1 of the copending application for the advantage of a convenient way of easily attaching and detaching the devices from the machine.

With respect to claim 17, the input power pin 264 and the other pin 31' are separated by a resistor 26 as shown in Figure 1 of Goers *et al.*

This is a provisional obviousness-type double patenting rejection.

#### ***Allowable Subject Matter***

6. Claims 8, 4-6, 11, 12, 14, 15, 17 and 19 would be allowable if a terminal disclaimer is filed as mentioned above.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel J. Colilla whose telephone number is 571-272-2157. The examiner can normally be reached on M-F 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Nguyen can be reached at 571-272-2258. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

September 9, 2008

/Daniel J. Colilla/  
Primary Examiner  
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